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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,788	02/17/2000	Richard E. Olson	PH-7076-A	7287

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT PAPER NUMBER

1624

DATE MAILED: 03/16/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/505,788

Applicant(s)

OLSON, RICHARD E.

Examiner

Brenda L. Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 10-14, 16, 20, 22, 23, 25-30, 33, 35-37, 39-45, 48, 50-52 and 54-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 10-14, 16, 20, 22, 23, 25-30, 33, 35-37, 39-45, 48, 50-52 and 54-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/24/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Claims 1-4, 6, 10-14, 16, 20, 22, 23, 25-30, 33, 35-37, 39-45, 48, 50-52 and 54-56 are pending in the application.

This action is in response to applicant's amendment dated December 5, 2003. Claims 1, 3, 4, 10-14 and 20 were amended and claims 8, 18, 31, 32, 34, 38, 45, 47, 49 and 53 were canceled.

Response to Arguments

Applicant's amendments and arguments filed December 5, 2003 have been fully considered with the following effect:

1. The applicant's amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of the last office action, which are hereby **withdrawn**.

In view of the amendment dated December 5, 2003, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claims 1, 10, 20, 22, 23, 39 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:
 - a) Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the definition of R2. There is no variable R2 in Formula (I). It is believed that the applicants intended R². (Claims 1, 22 and 23)

- b) Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by C1-C6 alkyl, it is believed that the applicants intended C₁-C₆ alkyl. (Claims 1, 22 and 23)
- c) Claim 10 is vague and indefinite in that it is not known what is meant by the definition of R³, which includes the two moieties in the third line from the bottom of page 25 where the moieties have a box in the middle of each, i.e. –CH₂C□CH and –CH₂C□C(CH₃).
- d) Claim 10 is vague and indefinite in that it is not known what is meant by the definition of R⁵, which includes the seven moieties in the last two lines of page 26 where the moieties have a box in the middle of each, i.e. –C□CH, –CH₂C□CH, –CH₂C□C(CH₃), –CH₂C□C(C₆H₅), –CH₂CH₂C□CH, –CH₂CH₂C□C(CH₃) and –CH₂CH₂C□C(C₆H₅).
- e) Claim 10 is vague and indefinite in that it is not known what is meant by the definition of R¹⁰. There is no variable R¹⁰ in the compounds of Formula (Ic).
- f) Claim 10 recites the limitation "=O" in the definition of R¹¹. There is insufficient antecedent basis for this limitation in the claim.
- g) Claim 20 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the definition of R¹⁰. There is no variable R¹⁰ in the compounds of Formula (Ic). (Claims 20, 39 and 54)
- h) Claim 20 recites the limitation "=O" in the definition of R¹¹. There is insufficient antecedent basis for this limitation in the claim. (Claims 20, 39 and 54)

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, 6, 10-14, 16, 20, 22, 23, 25-30, 33, 35-37, 39-45, 48, 50-52 and 54-56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 14-18, 20, 22 and 24-26 of copending Application No. 10/285,776. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the compounds of formula I in copending Application No. 10/285,776 embraces the compounds, compositions and method of use of the compounds of Formula (I) as claimed herein.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman
Primary Examiner Art Unit 1624
March 12, 2004